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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,267	07/24/2003	Shigekatu Sato		7602

7590 11/23/2004
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EXAMINER

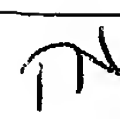
REDDICK, MARIE L

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 11/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/627,267	Applicant(s) SATO, SHIGEKATU 	
	Examiner Judy M. Reddick	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Response to Amendment

1. The amendment/substitute specification filed on 09/20/04 is/are sufficient to overcome the issues identified per paragraphs 2-4, 6 and 7 A) through C) and raised in the previous Office Action (05/17/04).

Specification

2. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification, as far as the Examiner can tell, does not provide proper antecedent basis for "0.1-10 parts by weight of an amino-group containing compound" per claim 4 (C). See page 24, lines 17-20.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The recited "An antistatic plastic resin formed product made from and comprising said antistatic plastic resin composition" per claim 5 engenders awkwardly expressed and confusing claim language. The following language is suggested: "An antistatic plastic resin formed product comprising said antistatic plastic resin composition described in claim 3 or 4".

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-5 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3 of copending Application No. 10/627,266 as evidenced by Nunn, Jr. et al. Although the

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conflicting claims are not identical, they are not patentably distinct from each other because the antistatic agent comprising a borate ester of polyoxyalkylene expressed by the formula (1)(claim 1), the antistatic agent according to claim 1, further comprising an amino group-containing compound(claim2), an antistatic plastic resin composition comprising (a) 100 parts by weight of a thermoplastic resin and (B) 0.1-10 parts by weight of an antistatic agent according to claim 1(claim 3), an antistatic plastic resin composition according to claim 3, further comprising (C) 0.1-10 parts by weight of an amino group containing compound(claim 4) and an antistatic plastic resin formed product(claim 5) per the instant claims overlaps in scope with the resin composition for purging away contaminant in a plastic processing machine which resin composition comprises (A) 100 parts by weight of a thermoplastic resin and (B) 0.1-10 parts by weight of a borate ester of polyoxyalkylene expressed by the formula (1)(claim 1), a resin composition, further comprising (C) 0.1-10 parts by weight of an amino group-containing compound(claim 2) and a purging method using the resin composition of claim 1(claim 3) per the claimed invention of copending application 10/627,266. A formed product from the resin composition of copending application 10/627,266 would have been obvious to the skilled artisan and with a reasonable expectation of success. The use of the claimed invention of copending '266 as an antistatic agent would be expected since the components of the invention, as claimed, per copending '266 are essentially the same as the components of the borate ester of polyoxyalkylene-containing antistatic agent per the instantly claimed invention and as evidenced by Nunn, Jr. et al who teach polyalkyleneoxy borates overlapping in scope with the borate ester of polyoxyalkylene per the claimed invention of copending'266 and the use thereof as an antistatic agent. This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the

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subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Nunn Jr., et al(U.S. 3,316,287) or Nunn Jr., et al(GB 1,090,565).

Nunn Jr., et al'287 and Nunn Jr., et al(GB'565) teach organic polyalkyleneoxy borates, useful as antistatic agents, characterized by the following general formula:

$[R-O-CH_2CH(R_1-O)]_m-1-(CH_2CH_2O)_n-3-B$ wherein R represents at least one member of the group consisting of either a straight or branched chain alkyl radical containing from 10 to 28 carbon atoms, e.g., decyl, hendecyl, dinonyl, dodecyl, tridecyl, tetradecyl, pentadecyl, hexadecyl, heptadecyl, octadecyl, nonadecyl, eicosyl, etc.- which are unsubstituted or substituted by a chloro or dichloro mono-, di- or tri-alkyl of from 1 to 18 carbon atoms, e.g., dimethylphenyl, dipropylphenyl, nonylphenyl, dinonylphenyl, octadecylphenyl, trioctadecylphenyl, etc., R₁ represents either hydrogen methyl, ethyl, phenyl or cyclohexene oxide and m and n represent a positive integer of from 1 to 150. See col. 1, lines 10-72, col. 2, lines 1-34, the Runs and claims of Nunn Jr., et al'287 and page 1, lines 6-40, page 2, lines 1-30, the Runs and claims of Nunn Jr., et al(GB'565). Nunn Jr., et al'287 and Nunn Jr., et al(GB'565) therefore anticipate the instantly claimed invention.

Even if it turns out that the claimed invention is not anticipated by the disclosures of Nunn Jr., et al'287 and Nunn Jr., et al(GB'565), it would have been obvious to the skilled artisan to extrapolate, from the disclosures of Nunn, Jr. et al'287 and Nunn Jr., et al(GB'565), the antistatic agent, as claimed, as per such having been within the purview of the general disclosures of Nunn Jr., et al'287 and Nunn Jr., et al(GB'565) and with a reasonable expectation of success.

Response to Arguments

10. Applicant's arguments filed 09/20/04 have been fully considered but they are not persuasive.

Relative to the OTDP Rejection---The provisional rejection under the judicially created doctrine of obviousness-type double patenting of claims 1-5 over claims 1-3 of copending application no. 10/627,266 as evidenced by Nunn, Jr. et al is deemed proper and stands. A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

A request that action in an application be delayed will be granted only under the

provisions of 37 CFR 1.103, which provides for "Suspension of Action." A petition for suspension of action under 37 CFR 1.103(a) must: (A) be presented as a separate paper, (B) be accompanied by the petition fee set forth in 37 CFR 1.17(h), (C) request a specific and reasonable period of suspension not greater than 6 months and (D) present good and sufficient reasons why the suspension is necessary. If the requirements of 37 CFR 1.103(a) are not met, applicants should expect that their applications, whether new or amended, will be taken up for action by the examiner in the order provided in MPEP § 708, Order of Examination.

Relative to Nunn, Jr. et al (U.S. 3,316,287 & GB 1,090,565)---It is urged and maintained that the organic polyalkyleneoxy borate compounds of Nunn, Jr. et al overlap in scope with the claimed borate ester of a polyoxyalkylene compound.

A SPECIES WILL ANTICIPATE A CLAIM TO A GENUS

"A generic claim cannot be allowed to an applicant if the prior art discloses a species falling within the claimed genus." The species in that case will anticipate the genus. In re Slayter, 276 F.2d 408, 411, 125 USPQ 345, 347 (CCPA 1960); In re Gosteli, 872 F.2d 1008, 10 USPQ2d 1614 (Fed. Cir. 1989) (Gosteli claimed a genus of 21 specific chemical species of bicyclic thia-aza compounds in Markush claims. The prior art reference applied against the claims disclosed two of the chemical species. The parties agreed that the prior art species would anticipate the claims unless applicant was entitled to his foreign priority date.

Conclusion

11. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Judy M. Reddick whose telephone number is (571)272-1110. The examiner can normally be reached on Monday-Friday, 6:30 a.m.-3:00 p.m..


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571)272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Judy M. Reddick
Primary Examiner
Art Unit 1713

JMR 
11/22/04